

REMARKS

Claims 1, 5, 7, and 9-12 are currently pending in the present application, with Claims 1, and 9-12 being amended. Reconsideration and reexamination of the claims are respectfully requested.

The Examiner objected to Claim 14 for reasons of informalities. This objection is moot in view of the canceled claim.

The Examiner rejected Claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over Ogino (U.S. patent no. 6,433,946) in view of Kato (U.S. patent no. 5,953,529) and further in view of Sugiyama et al. (U.S. patent no. 6,744,588). This rejection is respectfully traversed with respect to the amended claims.

As previously communicated, the present invention is directed to managing digital data wherein the digital data is protected by copyright protection. As recited in the claims, a user seeking to perform a specific process on a digital data (such as execution or duplication of the data for private use) is first restricted from performing the specific process and notified of a message calling his or her attention to the presence of a copyright protection associated with the digital data. The notification contains messages to which the user may respond to by accepting the content of the message.

Upon detecting that the user agreed to the content of the message, the restriction on the specific process is removed and the notification of the message is stopped. Thereafter, the user is permitted to access the digital data via the specific process without being annoyed by future message notifications.

In accordance with the claimed invention, the lifting of the restriction is specific to the recording medium on which the digital data is stored. Accordingly, if the user should remove the

storage medium and insert another one, the restriction will be reapplied (unless the user had previously accepted the copyright message of the replacement medium).

Applicants have further amended the claims to further clarify the claimed invention, including clarifying that the copyright restriction is removed at the time when the user agrees to the copyright protection.

As the Examiner repeatedly acknowledged, neither Ogino nor Kato contain any disclosure or suggestion of recording a state of setting of permission onto a removable storage medium. That is, neither reference teach or suggest, for instance, recording an indication of recording permission onto the removable disk containing the digital data to be duplicated.

However, the Examiner cites Col. 4, lines 1-7 and lines 31-36 of Sugiyama as making such a disclosure. Applicants respectfully disagree.

As previously submitted, Sugiyama is directed to a method for preventing unauthorized duplication of copyrighted content on recording mediums. Specifically, Sugiyama discloses a method by which "protective information" is recorded onto a recording medium to indicate whether copying of the content on the recording medium is permitted.

Col. 4, lines 1-7 and 31-36 of Sugiyama provides the following.

A blank tape containing previously recorded copy permission information is loaded in recording apparatus 2. The copy permission information indicates whether the AV or DTV data can be recorded onto the blank tape. For example, if the copy permission information is indicative of permission to copy or not onto a blank tape, copyrighted data can be properly protected.

...

Even when the protective information indicative of the copy inhibition is transmitted from the reproducing medium, where the copy permission information indicates that copying is permitted onto the recording medium, the AV or DTV data can be copied.

Again, Sugiyama simply teaches recording protective information onto pre-recorded recording medium (in this instance, a blank tape). There is simply no mention of recording setting information indicating of the removal of copyright restrictions, as recited in the claims. Accordingly, Applicants respectfully submit that the pending claims are not disclosed by the three cited references, even when combined. Applicants therefore maintain the submission that Claims 1, 5, 7, and 9-12 are not obvious in view of Ogino, Kato, and Sugiyama.

Furthermore, Applicants again traverse the Examiner's combination of the Ogino, Kato, and Sugiyama. The Examiner, at pages 2-3 of the Detailed Action, provided brief descriptions of the three references, but provided no reasons why one of ordinary skill in the art would have combined the three references at the time of the invention. Rather, the Examiner simply provided that "[t]herefore, it is proper to combine their teachings to address the claimed invention." Applicants submit that "[addressing] the claimed invention" cannot be used as a reason to combine the references, as doing so amounts to using the present invention as a blue print to reconstruct the claimed invention in hindsight. Even in view of the recent Supreme Court ruling in *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. April 30, 2007), the Examiner is still required to provide a reason why one of ordinary skill in the art would combine the references using the factors established under *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966). In this regard, Applicants respectfully submit as Exhibit 1 a copy of a May 3, 2007 memorandum issued by Deputy Director of the USPTO, advising that "it remains necessary to identify the reason why a person ordinary skill in the art would have combined the prior art elements in the manner claimed."

The Examiner rejected Claims 13-15 under 35 U.S.C. § 103(a) as being unpatentable over the combination of four references: Ogino, Kato, Sugiyama, and Kori (U.S. Patent No. 6,687,802). This rejection is moot in view of the canceled claims.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance.

An entry of amendment after final office action is respectfully submitted as proper, as none of the amendments raise any new issues requiring a new search. Specifically, the amendments are incorporation of subject matter previously recited in Claims 2-4, and 13-15.

The Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. 393032027500.

Dated: May 14, 2007

Respectfully submitted,

By 

David T. Yang

Registration No.: 44,415

MORRISON & FOERSTER LLP

555 West Fifth Street

Los Angeles, California 90013-1024

(213) 892-5587

EXHIBIT 1



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MEMORANDUM

DATE: May 3, 2007

TO: Technology Center Directors

FROM: *Margaret A. Focarino*
Margaret A. Focarino
Deputy Commissioner
for Patent Operations

SUBJECT: Supreme Court decision on *KSR Int'l. Co., v. Teleflex, Inc.*

The Supreme Court has issued its opinion in *KSR*, regarding the issue of obviousness under 35 U.S.C. § 103(a) when the claim recites a combination of elements of the prior art. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). A copy of the decision is available at <http://www.supremecourtus.gov/opinions/06pdf/04-1350.pdf>. The Office is studying the opinion and will issue guidance to the patent examining corps in view of the *KSR* decision in the near future. Until the guidance is issued, the following points should be noted:

(1) The Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

(2) The Court did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

(3) The Court rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. The Court specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.